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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9438-2

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on October 4, 2005

Signature

Typed or printed name

Joyce Paoli

Application Number

10/750,710

Filed

01/02/2004

First Named Inventor

Stephen P. DeLisle

Art Unit

3711

Examiner

Steven Wong

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 35,839☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

James R. Cannon

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Telephone number

10-4-2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE UNDER 37 C.F.R. 1.116  
EXPEDITED PROCEDURE EXAMINING GROUP 3711**

Attorney Docket No. 9438-2

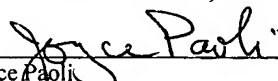
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Stephen P. DeLisle et al.  
Application No.: 10/750,710      Group Art Unit: 3711  
Filed: January 2, 2004      Examiner: Steven Wong  
For: GOLF TEE WITH SUPPORT PRONGS  
Date: October 4, 2005

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Joyce Paoli

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL  
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 09-0461.

**REMARKS**

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed July 5, 2005 (the Action). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005. :

Applicants believe that the rejections in the Action include clear errors as required by the rules connected with the Pre-Appeal Brief Conference.

**I. Rejections Based on Hodges in view of Clausing**

The Action states that Claims 1-4, 8-10, 12 and 13 are rejected under Section 103(a) based on U.S. Patent No. 1,645,000 to Hodges (Hodges) in view of U.S. Patent No. 1,644,979 to Clausing (Clausing). The Action states that Hodges discloses "a golf tee comprising an elongate shaft (10) and a support cup (11). The support cup has a discontinuous annulus (note Figure 2) defining three arcuate support prongs." Clausing is characterized as disclosing a golf tee including a support surface (8) that does not contact a golf ball. The Action states that it would have been obvious to form the golf tee of Hodges with a radius of curvature for the support surface such that the golf ball only contacts the prongs "in order to minimize the resistance to the golf ball at the moment of departure from the tee."

However, Applicant respectfully submits that the motivation cited in the Action to combine Hodges and Clausing is improper in view of the teachings of Hodges. As noted in the present specification, tees of the present invention may have a base upper portion that does not contact a golf ball in order to reduce the surface area of the tee that is in contact with the ball. The reduced surface area of contact can reduce the degree of friction between the ball and the tee, thereby increasing distance when the ball is struck with a golf club. In contrast, Hodges states that:

In order that the ball be more securely seated in the saucer shaped head of the tee, the edges of the head may be notched or recessed as indicated at 14 causing spaced sections in the edge of the rim to engage with the surface of the ball, these edge portions fitting into the dimples or recesses in the surface of the ball.

Hodges at page 1, lines 100-108. Thus, Hodges teaches that it is desirable that the ball be "securely seated" and that the "edge portions" of the "spaced sections" fit into the dimples or recesses in the ball. This teaching is in direct contrast to the desired result of a tee that has the prongs and concave base portion upper surface as recited in Claim 1. As such, Applicant

submits that the ordinarily skilled artisan would not have been motivated to combine Hodges with Clausing (and, in fact, would have been disinclined to do so). As such, it is clear error to combine these references.

## **II. Rejections Based on Hodges in View of Dawson**

The Action states that Claims 15-19, 22-27, 29-33, 36-40, 42 and 43 are unpatentable under Section 103(a) based on Hodges in view of U.S. Patent No. 2,693,358 to Dawson (Dawson). More specifically, the Action concedes that Hodges fails to disclose or teach support prongs that have convex contact surfaces, but cites Dawson as disclosing a convex contact surface 15 in Figure 3a. Based on this disclosure, the Action concludes that it would have been obvious to the ordinarily skilled artisan to form the prongs of the Hodges tee with convex contact surfaces as suggested in Dawson.

In response, Applicant notes that both the CCPA and the Federal Circuit have consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the primary reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot properly be made. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Such would clearly be the case with the rejection at hand. As noted above, the Hodges tee lacks the convex contact surfaces recited in independent Claims 15, 29 and 43. Hodges also states that the "edge portions" between the "spaced sections" are included so that "the ball may be more securely seated in the saucer shaped head of the tee," and that the "edge portions . . . [fit] into the dimples or the recesses of the golf ball." Thus, it is clear that the purpose of the spaced sections and edge portions of the Hodges tee are to increase, rather than decrease, interaction between the tee and ball. Conversely, the inclusion of convex surfaces on support prongs as recited in Claims 15, 29 and 43 can reduce the amount of contact area, and consequently friction and the like, between the tee and golf ball. Inasmuch as modifying the Hodges tee with convex surfaces as disclosed in Dawson would destroy the purpose of the edge portions of the Hodges tee, Applicant submits that a rejection based on Hodges in view of Dawson is improper and clearly erroneous.

Serial No. 10/750,710

Filed January 2, 2004

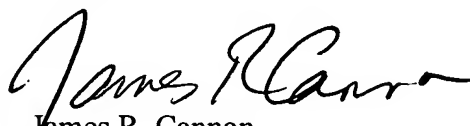
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In addition, Applicant notes that it is not entirely clear from Figure 3a of Dawson that the ball would actually rest on the bead 15; it may instead rest on the upper edges of the tube 12. As such, it is not clear that Dawson discloses this element. Of course, if this element is not present in Dawson, the rejection under Section 103(a) is clearly erroneous and cannot stand.

### **III. Conclusion**

In view of the foregoing, Applicant respectfully submits that the rejections set forth in the Action are clearly erroneous. Therefore, Applicant respectfully requests that the rejections of the present application be reviewed and reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,

  
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